



15 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Antoinette F. Konski
McCutchen, Doyle, Brown & Enersen LLP
3 Embarcadero Center, Suite 1800
San Francisco, CA 94111

In re Application of JEN et al
U.S. Application No.: 09/646,478
Int. Application No.: PCT/US99/06947
Int. Filing Date: 30 March 1999
Priority Date: 31 March 1998
Attorney Docket No.: 126881201800
For: METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER

DECISION

This is in response to applicant's "Renewed Request Under 37 C.F.R. § 1.497(d) and Petition for Suspension of the Rules Under 37 C.F.R. § 1.183" filed 08 August 2002.

BACKGROUND

On 30 March 1999, applicant filed international application PCT/US99/06947, which claimed priority of an earlier United States application filed 31 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 September 2000.

On 15 September 2000, applicant filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 17 January 2001, applicant filed a "Response to Notice of Missing Requirements" which included, *inter alia*, a declaration, an assignment document, and the required late declaration surcharge.

On 20 April 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed 17 January 2001 is improper since the declaration lists an inventor who is not listed on the international application.

On 21 May 2001, applicant filed a request to correct inventorship under 37 CFR 1.497(d).

On 14 August 2001, this Office mailed a decision dismissing the 21 May 2001 request to correct inventorship.

On 04 March 2002, applicant filed a renewed request under 37 CFR 1.497(d) along with new declarations.

On 20 March 2002, this Office mailed a decision dismissing the 04 March 2002 renewed request on grounds that consent of the assignee had not been properly established.

On 14 May 2002, applicant filed a renewed request under 37 CFR 1.497(d).

On 19 June 2002, this Office mailed a decision dismissing the 14 May 2002 renewed request on grounds that consent of the assignee had not been properly established.

On 08 August 2002, applicant filed the present renewed request under 37 CFR 1.497(d).

DISCUSSION

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Applicant has previously satisfied items (1) and (2) above.

With regard to item (3) above, the assignee must establish ownership of the application in order to consent to a correction of inventorship. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

Documentation relating to the following three entities appears in the application file: 1) AgraQuest, Inc., 2) Genzyme Corporation, and 3) Johns Hopkins University.

AgraQuest Inc.

On 30 March 2001, applicants filed a "Prosecution by Assignee and Power of Attorney Under 37 C.F.R. § 3.71" which states that AgraQuest, Inc. is the assignee of the entire right, title, and interest in the present application. The 14 May 2002 renewed request states that this document was filed erroneously without deceptive intent. Applicant's explanation for the discrepancy is accepted.

Genzyme Corporation

On 17 January 2001, applicant filed a "Certificate Under 37 CFR § 3.73(b)" which states that Genzyme Corporation is an assignee of part interest in the present application. On 08 August 2002, applicant filed copies of assignment agreements signed by joint inventors Gary Beaudry, Stephen Madden and Arthur Bertlesen. Such assignment agreements properly establish a chain of title from Beaudry, Madden, and Bertlesen to Genzyme Corporation.

On 04 March 2002, applicant filed a "Consent of Assignees to Change Inventorship" signed by Thomas DesRosier. Mr. DesRosier is recognized as having apparent authority to act on behalf of Genzyme Corporation by virtue of the "Certificate Under 37 CFR § 3.73(b)" filed 17 January 2001, in which Mr. DesRosier is identified as holding the title of Senior Vice President. Therefore, the consent document filed 04 March 2002 constitutes sufficient written consent of the assignee.

Johns Hopkins University

On 30 April 2001, applicant filed a "Statement Under 37 CFR 3.73(b)" which states that Johns Hopkins University is an assignee of part interest in the present application. The statement was accompanied by copies of assignment agreements signed by joint inventor Jin Jen and purported joint inventor David Sidransky. Such assignment agreements properly establish a chain of title from Jen and Sidransky to Johns Hopkins University.

On 04 March 2002, applicant filed a "Consent of Assignees to Change Inventorship" signed by R. Keith Baker. The "Substitute Certificate Under 37 CFR § 3.73(b)" filed 08 August 2002 states that Mr. Baker has authority to act on behalf of Johns Hopkins University. Therefore, the consent document filed 04 March 2002 constitutes sufficient written consent of the assignee.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.497(d) is GRANTED.

The application has an International Filing Date of 30 March 1999 and a date under 35 U.S.C. 371(c) of 04 March 2002.

The application is being forwarded to the DO/EO/US for processing in accordance with this decision.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614

Facsimile: 703-308-6459